From: JIngerman@fishneave.com
Sent: Tuesday, August 19, 2003 1:04 AM
To: AB63 Comments
Subject: Comments - Clarification of Power of Attorney Practice, and Revis ions to Assignment Rules

> The undersigned presents the following comments on the June 27, 2003
> notice of proposed rulemaking entitled "Clarification of Power of Attorney
> Practice, and Revisions to Assignment Rules" (68 FR 38258).
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> The changes regarding powers of attorney fail to reflect a number of
> business realities. First, the elimination of associate powers of
> attorney is based on the availability of customer number practice but
> fails to recognize that in many cases individuals associated with more
> than one customer number may be involved with a particular patent
> application. This is particularly the case in the corporate context where
> both inside and outside counsel are involved. If, for example, inside
> counsel prepares and files an application and has power of attorney, and
> later wants outside counsel to participate in prosecution, and to be the
> correspondence address, under the proposed rules a new power of attorney
> would have to be filed. Although in such a situation, it might not be
> difficult to find a corporate officer to sign such a power of attorney, in
> some situations, depending on corporate policies and the geographic
> locations of officers relative to the corporate facility responsible for
> the application, it might be difficult. And in situations involving
> foreign clients, it could become very difficult.
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> Similarly, if an applicant wants to change counsel, a new power of
> attorney is required. At present, an associate power of attorney signed
> by original counsel, which frequently can be obtained almost immediately,
> is a useful stopgap for making new counsel of record and changing the
> correspondence address until an officer of the applicant can sign a new
> power of attorney. This expedient will disappear. As a result, papers
> will continue to be mailed to original counsel for a longer period of time
> and will have to be forwarded to new counsel, resulting in delays in the
> receipt of papers by new counsel . Again, this situation is exacerbated
> in the case of a foreign client, because of the longer delays in obtaining
> a new power of attorney.
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> Second, the proposal to limit the number of practitioners who can be
> designated individually, instead of by customer number, fails to recognize
> that in some cases, for litigation reasons, some practitioners associated
> with a customer number may not want to be considered to have been of
> record in a particular application, (but they may want to be of record on
> other applications, so they want to remain associated with the customer
> number).
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> The Office's justification for these changes is the alleged undue burden
> on the Office of manually entering lists of practitioner names or
> registration numbers. However, the Office does not have to enter any
> lists of practitioner names or numbers if an application is filed
> electronically; the "burden" will be on applicant to enter registration
> numbers at the time of submission. In addition, for applications that are
> not filed electronically, applicant can enter the registrations numbers on
> an optically-scannable data sheet, such as that created using the Office's
> PrintEFS software. The undersigned understands that the Office no longer
> scans such data sheets, but urges the Office to resume doing so, and to

> provide an updated version of PrintEFS (at least until a user-friendly
> alternative to the current EFS system has been put in place). Even if the
> Office were to have to enter names or numbers manually, the undersigned is
> not sympathetic. The office is using the excuse of undue burden to
> justify yet another in a long line of attempts (too many of which have
> been successful) by the Office to take away substantive rights (here, the
> right to counsel of one's choice) for administrative convenience.
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> With regard to the changes in assignment practice, the undersigned
> believes that it is still useful for the Office to return the recorded
> document as an indication, even if informal, of what has been recorded.
> From time to time, the undersigned has received back a Notice of
> Recordation that correctly reflects the assignment that was sent in, but
> to which is attached a completely different assignment (of another
> applicant and assignee). Although it is possible in such a case that the
> assignment was recorded correctly, and the mix-up occurred in collating
> the documents for return, it is also possible that the mix-up occurred
> before the documents were recorded, meaning that the assignment at a
> particular reel and frame location might not match the computer abstract
> for that location. If the recorded assignment is returned with the Notice
> of Recordation, at least there is a clue that the Assignment Division
> needs to be notified of a possible recordation error. Under the proposed
> practice, such errors would go undetected until an assignment actually
> became a litigation issue, by which time it might be impossible to
> reconstruct what happened and correct the error.
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> If the proposal to stop returning the recorded assignment with the Notice
> of Recordation is adopted, the undersigned suggests that the Notice of
> Recordation include not only the title, but also the Attorney Docket
> Number (if provided by applicant). The proposal to provide the title to
> distinguish among multiple applications with a given filing date is
> insufficient, because on occasion multiple applications with the identical
> titles are filed together. In addition, or alternatively, the Office
> could provide the Express Mail Label Number as a means of identification
> for an application filed by Express Mail under 37 CFR 1.10.
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> The undersigned is a partner in the intellectual property law firm of Fish
> & Neave. However, these comments are those of the undersigned alone, and
> do not necessarily reflect the views of Fish & Neave.
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